



Response Under 37 C.F.R. § 1.116
Group Art Unit 1771, Expedited Procedure

03500.012902

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
HAJIME YAMAMOTO, et al.) Examiner: J. Guarriello
Application No.: 09/132,746) Group Art Unit: 1771
Filed: August 12, 1998)
For: FIBROUS MATERIAL,)
PRODUCTION PROCESS OF THE :
FIBROUS MATERIAL, INK-)
ABSORBING MEMBER, :
TREATING PROCESS OF THE)
INK-ABSORBING MEMBER, INK :
TANK CONTAINER AND INK)
CARTRIDGE : November 3, 2003

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RESPONSE TO FINAL REJECTION


Sir:

This is in response to the Office Action dated June 3, 2003 (Paper No. 28), the period for response to which having been extended to November 3, 2003 by the accompanying Petition For Extension Of Time. Claims 1 to 6, 11 to 25, 30 to 39, 42, 47 to 62, 65, 68 to 76 and

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Michael K. O'Neill, Reg. No. 32,622
(Name of Attorney for Applicant)


Signature Date of Signature

November 3, 2003
Date of Signature

79 to 95 are in the application. Claims 1 to 6, 11 to 17, 31 to 39, 54 to 62, 79, 82, 83, 87, 90 and 92 have been withdrawn from further consideration on the merits pursuant to a Restriction Requirement entered on April 30, 2000, and modified on September 11, 2000. Thus, Claims 18 to 25, 30, 42, 49 to 53, 65, 68 to 76, 80, 81, 84 to 86, 88, 89, 91 and 83 to 95 have received an action on the merits. Reconsideration and further examination are respectfully requested.

The Office Action maintains its objection to Claims 18, 42 and 65, for the reason that these claims are written in dependent form depending from claims that have been withdrawn from further consideration. Accordingly, since this objection is based on the restriction requirement, which Applicants continue to believe has been entered improvidently, the formatting of these claims has not been changed.

Claims 18 to 21, 30, 42, 65, 71, 72, 76, 88 and 89 were rejected under 35 U.S.C. § 102(b) over European 771,662 (Yamamoto '662); Claims 18 to 25, 30, 42, 47 to 53, 65, 68 to 76, 80, 81, 84 to 86, 88, 89 and 93 to 95 were rejected under § 103(a) over U.S. Patent 5,784,088 (Ujita '088) in view of U.S. Patent 5,509,140 (Koitabashi '140); Claims 22 to 25, 47 to 53, 68 to 70, 73 to 75, 84 to 86 and 93 to 95 were rejected under § 103(a) over Yamamoto '662 in view of Koitabashi '140; and Claims 18 to 25, 30, 42, 47 to 53, 65, 68 to 76, 80, 81, 84 to 86, 88, 89 and 93 to 95 were rejected for obviousness-type double patenting over issued Claims 1 to 22 of U.S. Patent 6,234,618 (Yamamoto '618) in view of Yamamoto '662. The rejections are respectfully traversed.

As explained in prior responses, the claims are directed to a fibrous material produced by steps which include processing with a glycol treatment, or treatment with a treating agent. The glycol treatment involves contact with an ethylene oxide adduct of a glycol having a

cloud point of at least 65°C, and the treating agent likewise contains an ethylene oxide adduct of a glycol having a cloud point of at least 65°C.

The advantageous effects of the present invention are described throughout the specification and have been discussed in previous responses. Among these advantages is the reduction in leeching effects of additives which are often contained in the thermoplastic resins which form fibrous materials. Without processing with the glycol treatment, or treating with the treating agent, these additives otherwise tend to leech from the fibrous materials in the ordinary course, causing deleterious effects particularly in instances where the fibrous materials are used in connection with an ink absorbing member. The glycol treatment or the treating agent serves to emulsify or solubilize additive components which, in turn, allows much of these components to be removed from the fibrous materials. Consequently, many of the undesired components are removed and never come in contact with or contaminate ink.

It is Applicants' continued position that the applied art, whether taken alone or in any permissible combination, fails to disclose or reasonably to suggest processing with a glycol treatment (or treatment with a treating agent) using an ethylene oxide adduct of a glycol having a cloud point of at least 65°C. It is Applicants' further position that the applied art fails to disclose or suggest the attendant benefits of such processing or treatment.

In maintaining the § 102(b) rejection, the Office Action focused on excerpts from page 8 of Yamamoto '662 in support of its conclusion that Yamamoto '662 teaches a polyether-type surfactant "which inherently encompasses the instantly claimed ethylene oxide adduct of a glycol". Additional citations were made to Yamamoto '662's page 8, and it is

apparent that the Office Action has taken the position that the ethylene oxide adduct of glycol used in the present invention is somehow described in Yamamoto '662.

Applicants respectfully disagree with this position. It is true that Yamamoto '662 describes a non-ionic surfactant and that the ethylene oxide adduct of a glycol used in the present invention is likewise a non-ionic surfactant. However, the similarities end there. Yamamoto '662 discloses only glycols that are outside the scope of the present invention. Page 8 of Yamamoto '662 clearly teaches a polyethylene glycol type non-ionic surfactant, and a polyhydric alcohol type non-ionic surfactant; however, it is technologically illogical to conclude that such surfactants somehow imply the ethylene oxide adduct of a glycol according to the invention.

Simply put, the ethylene oxide adduct of glycol according to the invention, and the non-ionic surfactants of Yamamoto '662, are different. There is neither technological nor art-based reasons to expect that the non-ionic surfactants of Yamamoto '662 could somehow lead those of ordinary skill to the ethylene oxide adduct of a glycol according to the invention.

Moreover, Applicants again stress that Yamamoto '662 nowhere mentions the advantageous effects of the present invention. Applicants recognize that these advantageous effects are not being claimed. Rhetorically speaking, however, Applicants observe that given the clear advantageous effects of the present invention, then if Yamamoto '662 disclosed the invention identically, it surely would have noticed these effects.

It is therefore respectfully submitted that the claims herein are novel over Yamamoto '662.

With respect to the § 103(a) rejection over Ujita in view of Koitabashi, Applicants respectfully reassert their position that it would not have been obvious to use the glycol-charged ink of Koitabashi as a kind of "treatment" or "treating agent" for the absorbing material of Ujita. In particular, as understood, the rejection takes the position that in view of Koitabashi's teaching of control over surface tension of ink in a cartridge by a surfactant, that those of ordinary skill would have been motivated to apply Koitabashi's surfactant (one example of which is acetylene glycol ethylene oxide) as a treatment to an absorbing material.

Even as so-understood, however, such a position falls far short of the claimed "glycol treatment" or use of a "treating agent" as defined by the rejected claims. It is noted, for example, that the present specification, beginning at line 14 on page 14, indicates that treatment should be performed "at anytime before contact with an ink upon their [the fibrous material's] use". Thus, use of ink that contains a surfactant is not the same as a "treatment" as claimed herein.

Likewise, with respect to the § 103(a) rejection over Yamamoto '662 in view of Koitabashi, even if there were motivation to combine the two references, Yamamoto '662 does not described the ethylene oxide adducts of glycol as claimed herein. Indeed, the Office Action explicitly concedes that Yamamoto '662 "differs from the claimed invention because the treating agent glycol is different".

Turning to the obviousness-type double patenting rejection over Yamamoto '618, the Office Action asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the hydrophobicity of the fibers claimed in Yamamoto '618 with the surfactant of Yamamoto '662. It is again noted that Yamamoto '618 is the U.S.

counterpart to Yamamoto '662, and as discussed above, Yamamoto '662 does not provide for the glycol treatment or the treatment agent of the present invention. Accordingly, even if it would have been obvious to use surfactants from Yamamoto '662 in the claimed fibers of Yamamoto '618, the present invention would not have resulted, for the reason that the surfactants are different.

No other matters being raised, it is believed that the entire application is fully in condition for allowance, and such action is courteously solicited.

In addition, upon an indication of allowable subject matter in the elected claims, it is respectfully requested for the Examiner to re-join the withdrawn claims pursuant to the procedure in MPEP § 809 et seq.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our address given below.

Respectfully submitted,


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